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Mr. Joseph S. Tripoli
Thomson Multimedia Licensin
P O Box 5312
Princeton, NJ 08540

EXAMINER	
SALCE, JASON P	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KEITH R. WEHMEYER

Appeal 2008-1129
Application 09/981,000
Technology Center 2600

Decided: September 11, 2008

Before KENNETH W. HAIRSTON, JOHN A. JEFFERY,
and R. EUGENE VARNDELL, JR., *Administrative Patent Judges*.

VARNDELL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's rejection of claims 1-5. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

The invention claimed on appeal is a method for forming a combined program guide comprising the steps of receiving first program guide information from a first signal source, receiving second program guide information and a second signal source from a stand-alone digital video receiver, integrating the first program guide information with the second program guide information to form a combined program guide, and outputting data representative of the combined program guide to a display device (Spec. 3, 4, 9). The preamble of claim 1 on appeal describes a stand-alone internet receiver (32) for receiving internet data and analog program information including first program guide information, coupled to a stand-alone digital video receiver (10) for receiving digital program information including second program guide information (Spec. 3, 4, Fig. 1). Claim 2 on appeal defines that the stand-alone internet receiver receives the first program guide information via a vertical blanking interval (VBI) of an analog signal.

Claim 1, the only independent claim on appeal, and claim 2 are reproduced below:

1. In a stand-alone internet receiver for receiving internet data and analog program information including first program guide information, coupled to a stand-alone digital video receiver for receiving digital program information including second program guide information, a method for forming a combined program guide comprising steps of:

receiving the first program guide information from a first signal source;

receiving the second program guide information from the stand-alone digital video receiver, wherein the stand-alone digital video receiver receives the second program guide information from a second signal source;

integrating the first program guide information with the second program guide information to form the combined program guide; and

outputting data representative of the combined program guide to a display device.

2. The method of claim 1, wherein the stand-alone digital video receiver receives the second program guide information via a digital data stream, and the stand-alone internet receiver receives the first program guide information via a vertical blanking interval of an analog signal.

The Examiner relies on the following prior art references to show unpatentability:

Schein	US 5,801,787	Sept. 1, 1998
Kaplan	US 6,058,430	May 2, 2000
Sampsell	US 6,219,839 B1	Apr. 17, 2001

The rejection mailed on September 25, 2006 set forth the following rejections of claims 1-5 on appeal:

1. Claims 1, 2, and 5 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over Schein in view of Kaplan.
2. Claims 3 and 4 stand rejected as being unpatentable under 35 U.S.C. § 103(a) over Schein in view of Kaplan in further view of Sampsell.

Rather than repeat the arguments of Appellant or the Examiner, we refer to the Appeal Brief filed on January 8, 2007, the Examiner's Answer mailed on May 15, 2007, and the Reply Brief filed on July 13, 2007 for their respective details. Appellant collectively argues independent claims 1, 2, and 5 (App. Br. 3-6; Reply Br. 1-5). Appellant's Briefs contain no separate arguments for dependent claims 3 and 4, but simply refer back to the

arguments made with respect to claims 1, 2, and 5. Accordingly, dependent claims 3 and 4 are grouped together with independent claim 1 and stand or fall with the rejection of claim 1. Arguments which Appellant could have made but did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUES

Has Appellant established that Schein alone or combined with Kaplan do not disclose or suggest all limitations in claims 1, 2, and 5 on appeal?

Has Appellant established that one of ordinary skill in art would not combine the teachings of Schein and Kaplan in the manner proposed in the rejection?

OPINION

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966).

Obviousness of Claims 1 and 5

The Examiner refers to Schein at Figure 1 and column 4, lines 25-39 (Ans. 3-4). The Examiner explains that Schein teaches cable box (16) is a stand-alone receiver receiving analog program information from a first source, the analog program information including first program guide information (Ans. 3-4). The Examiner also explains that a digital broadcast

source (DBS) receiver (18) of Schein is a stand-alone receiver receiving digital program information from a second source, the digital program information including second program guide information (Ans. 3-4). The Examiner further explains that Schein discloses integrating the first program guide information with the second program guide information to form the combined program guide and outputting data representative of the combined program guide to a display device (Ans. 4). Appellant does not contest these factual findings of the Examiner (App. Br. 3-6; Reply Br. 2-5). These factual findings alone meet all limitations in claim 1 on appeal. The teachings of Kaplan bolster those of Schein, as discussed below. Therefore, the combination of Schein and Kaplan establish a prima facie case of obviousness for the invention defined in claim 1 on appeal. Accordingly, we affirm the Examiner's rejection of claims 1 and 5 under § 103.

Appellant argues that one of ordinary skill in the art would have absolutely no motivation to modify Schein in the manner proposed by Kaplan. Some of these arguments are concerned with the stand-alone internet receiver receiving the first program guide information via a vertical blanking interval (VBI) of an analog signal, which is defined in claim 2. These arguments are irrelevant to claim 1 on appeal, because claim 1 does not require the use of VBI. This limitation, which is set forth in claim 2 on appeal, is discussed later in this Opinion when discussing claim 2.

Appellant argues that cable box (16) of Schein (the alleged "stand-alone internet receiver") does not receive program guide information from DBS source/IRD box (18) (the alleged "stand-alone digital video receiver"), as required by claim 1 (App. Br. 6). Appellant explains that coordinator (14), not cable box (16), receives and arranges program schedule

information (App. Br. 6). The Examiner notes that claim 1 does not require that the stand-alone Internet receiver receives the second program information from the stand-alone digital receiver or that the stand-alone Internet receiver integrates the first and second program guide data to form the combined program guide (Ans. 9). The Appellant replies that these limitations are contained in claim 1 by the preamble of "In a stand-alone internet receiver…." (Reply Br. 4-5).

We agree with the Examiner. The disputed limitations of the preamble of claim 1 merely recite the intended use of a structure, while the claim defines a method. Furthermore, the body of the claim does not depend on the preamble for completeness but, instead, the process steps are able to stand alone. *See In re Hirao*, 535 F.2d 67, 70 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152 (CCPA 1951). In other words, claim 1 on appeal does not require that the "stand-alone internet receiver" receives program guide information from the stand-alone digital video receiver or integrate the first and second guide information to form the combined program, but only that the claimed method performs these process steps. Since claim 1 does not require that the "stand-alone internet receiver" performs the process steps, any lack of such teachings in Schein or Kaplan cannot establish error in the Examiner's rejection.

More importantly, Schein explains that the coordinator (14) can be placed in the cable box (16) (col. 4, ll. 9-12). When the coordinator is placed in the cable box as taught by Schein, the combined coordinator/cable box meets Appellant's proffered interpretation of claim 1, namely, a stand alone internet receiver that receives program guide information from the stand-alone digital video receiver, integrates the first and second program

guide information to form the combined program guide, and outputs data representative of the combined program to a display device. See, for example, column 4, lines 40-54 and Figure 1 of Schein. Based on these and the previously-mentioned factual findings, the Examiner has established a prima facie case of obviousness for claim 1 on appeal.

Even without the teaching in Schein of placing the coordinator (14) in the cable box (16), one of ordinary skill in the art would have found arranging the coordinator within or together with the cable box of Schein obvious. See, for example, *KSR Int'l v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740 (2007), where the Court explained, when discussing the question of obviousness of a patent that claims a rearrangement of known elements, that:

> [W]hen a patent "simply arranges old elements with each performing the same function it had been known to perform" and yields no more than one would expect from such an arrangement, the combination is obvious. *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976).

Since the method steps in the invention claimed on appeal could be performed by simply arranging the coordinator and cable box of Schein together to perform the same functions they perform separately, the method steps in the invention claimed on appeal would have been obvious to one of ordinary skill in the art.

For these reasons, we find no error in the Examiner's rejection of claims 1 and 5 as being unpatentable under 35 U.S.C. § 103(a) over Schein in view of Kaplan. Therefore, we affirm the Examiner's rejection of claims 1 and 5.

Obviousness of Claim 2

Claim 2 on appeal defines, among other things, the vertical stand-alone internet receiver receives the first program guide information via a vertical blanking interval (VBI) of an analog signal. Appellant argues that modifying the cable box (16) of Schein to use scan lines 10 through 20 of the VBI to receive internet data, as taught by Kaplan (see column 4, lines 35-41), would prevent the cable box (16) from using those scan lines to receive program guide information (App. Br. 4, Reply Br. 2). Appellant continues that since such a modification would prevent and thereby at least partially defeat one of the primary objectives of Schein; namely, the ability to receive and process program guide information from multiple sources including cable box (16), one of ordinary skill in the art would have absolutely no motivation to combine the teachings of Schein and Kaplan in the manner proposed by the Examiner (App. Br. 4).

Kaplan teaches a stand-alone Internet receiver that receives both Internet data and analog program information (Fig. 1, col. 4, ll. 23-41), as explained by the Examiner (Ans. 4). Kaplan also provides a factual basis of the use of VBI to digitally embed internet information in a stand-alone receiver (Kaplan col. 4, ll. 23-41; Ans. 4, 7, 8). In addition to teaching a stand-alone cable box receiving analog program information (Fig. 1, col. 4, ll. 25-39) as explained by the Examiner (Ans. 3-4), Schein teaches that the coordinator (14) may receive program schedule information via the vertical blanking interval (VBI) in a television channel or via a transponder for the DBS, or the internet (col. 4, ll. 49-54). Elsewhere, Schein teaches receiving program information through the cable box (16) where television schedule data is provided within the signal (i.e., VBI) transmitted by the service

provider (col. 4, ll. 33-39). As discussed above, Schein teaches that the coordinator can be placed in the cable box (col. 4, ll. 9-12). Thus, the combination coordinator/cable box of Schein is a stand-alone digital video receiver that receives the first program guide information (or embedded Internet information as taught by Kaplan) via a vertical blanking interval of an analog signal, as required in claims 1 and 2 on appeal.

Furthermore, concerning Appellant's argument that the Examiner's modification of Schein by Kaplan makes Schein at least partially inoperable, Appellant provides no evidence and we find no evidence in the record supporting such inoperability. Without a sufficient factual basis establishing that modifying Schein based on Kaplan would render Schein inoperable, we can find no error in the Examiner's combination of Schein and Kaplan. *See In re Geisler*, 116 F.3d 1465 (Fed. Cir. 1997); *In re Wood,* 582 F.2d 638, 642 (CCPA 1978); *In re Lindner,* 457 F.2d 506, 508 (CCPA 1972).

Appellant argues that the meaning of the expression "'descriptional, informational or promotional message … *about the Internet site* associated with the broadcast'" as taught by Kaplan is not the same as the meaning of the expression "program guide information" as required in the claims on appeal (Reply Br. 2-3). Appellant argues that the difference between these expressions supports the argument that Kaplan does not teach that the VBI can be used for receiving both internet data and program guide information and supports his argument that the Examiner's proposed modifications of Schein based on Kaplan would render Schein at least partially inoperable. The alleged inoperability of Schein modified by Kaplan was discussed and dismissed above.

Concerning the differences between the previously mentioned expression in Kaplan and the claims on appeal; during examination of a patent application, pending claims are given their broadest reasonable construction consistent with the specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364, (Fed. Cir. 2004). We believe that the broadest reasonable construction consistent with the specification for the expression "program guide information" in the claims on appeal overlaps or encompasses the expression "descriptional, informational or promotional message" taught by Kaplan. In other words, we can find no patentable distinction between these expressions. Namely, the "program guide information" of the claims on appeal necessarily includes descriptional, informational, or promotional messages. Therefore, we find no error in the Examiner's interpretation of the teachings of Kaplan or the Examiner's combination of Schein and Kaplan based on these expressions.

In conclusion, Appellant has not established error in the Examiner's rejection of claim 2 on appeal. Therefore, we affirm the Examiner's rejection of claim 2 together with claims 1 and 5 as being unpatentable under 35 U.S.C. § 103(a) over Schein in view of Kaplan.

Obviousness of Claims 3 and 4

Appellant's Brief and Reply Brief contain no separate arguments for dependent claims 3 and 4, but simply refer back to the arguments made with respect to claims 1, 2, and 5. For example, Appellant argues that Sampsell does not cure or rectify the deficiencies in the teachings of Schein and Kaplan. Since we find that the Appellant has not established any error in the

Examiner's rejection of the claims on appeal over Schein alone or combined with Kaplan, we affirm the Examiner's § 103(a) rejection of claims 3 and 4 that depend from claim 1 for the reasons set forth above.

CONCLUSION

In conclusion, based upon the factual findings set forth in the Answer and above, we determine that the Examiner has established a prima facie case of obviousness which has not been sufficiently rebutted by Appellant. Hence, we hold that the preponderance of evidence weighs most heavily in favor of obviousness within the meaning of 35 U.S.C. § 103. Accordingly:

1. The Examiner's rejection of claims 1, 2, and 5 as being unpatentable under 35 U.S.C. § 103(a) over Schein in view of Kaplan is affirmed; and
2. The Examiner's rejection of claims 3 and 4 as being unpatentable under 35 U.S.C. § 103(a) over Schein in view of Kaplan in further view of Sampsell is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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Mr. Joseph S. Tripoli
Thomson Multimedia Licensin
P. O. Box 5312
Princeton, NJ 08540